UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,290	11/19/2003	Jeff Hooker	AOL0153	1210

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER
SHAN, APRIL YING

ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/718,290	HOOKER ET AL.
	Examiner	Art Unit	
	APRIL Y. SHAN	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-25 and 27-38* is/are pending in the application.
    4a) Of the above claim(s) *1-6 and 32-38* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *7-9, 11-25 and 27-31* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   A Request for Continued Examination under 37 CFR 1.114, including the fee

set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR

1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous office action has been withdrawn pursuant to 37 CFR

1.114. Applicant's submission filed on 19 June 2008 has been entered.

2.   Claims 7 and 23 have been amended. Claims 10 and 26 have been

canceled. Claims 1-6 and 31-38 are withdrawn from consideration due to

restriction requirement. No new claims have been added. Claims 7-9, 11-25

and 27-31 are now presented for examination.

3.   Applicant's amendments and argument have been fully considered, but are moot

in view of new ground rejection as set forth below.

Priority

4.   Applicant claimed that the current application claims priority to U.S. Provisional

Application No. 60/427,568, entitled "IM Enterprise features," filed Nov. 20, 2002.

Examiner had reviewed carefully the U.S. Provisional Application (60/427,568).

The U.S. Provisional application (60/427,568) only broadly discloses secure AIM.

However, the examiner discovered at least three claim limitations, the secure message

are signed and encrypted **using subscriber's digital certificates**, submitting a

certificate publication request, the publication request also specifying a digital certificate

corresponding to the subscriber device, responsive to each certificate publication

request, the messaging server temporarily storing the submitted digital certificate in a

publication record in the independent claim 1 of the current application are **not**

supported by the U.S. Provisional application (60/427,568). Therefore, the examiner

will not grant the priory date as claimed. The effective filling date of the current

application is the filling date of the current application, which is 19 November 2003.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and requirements
> of this title.

6.   Claims 23-25 and 27-31 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claims 23-25 and 27-31 are directed to a messaging server for use in managing

the exchange message. Computer-readable data storage medium is being recited in

claim 23. The examiner carefully and respectfully reviews page 9 of the original

disclosure, the Applicant defines a computer-readable data storage media as being a

signal bearing media including analog or digital transmission media and analog….

Computer data signal and carrier wave are not limited to that which falls within a

statutory category of invention because it is not limited to a process, machine,

manufacture, or a composition of matter. Instead, it includes a form of energy. Energy

does not fall within a statutory category since it is clearly not a series of steps or acts to

constitute a process, not a mechanical device or combination of mechanical devices to

constitute a machine, not a tangible physical article or object which is some form of

matter to be a product and constitute a manufacture, and not a composition of two or

more substances to constitute a composition of matter (MPEP 2106).

In order to overcome the rejection, the examiner suggests the Applicant to delete

the word "signal-bearing" and "or other suitable signal-bearing media including analog

or digital transmission media...and wireless communications" from the original

disclosure's par. [1027]. Please also remove "signals" and "electromagnetic waves"

from par. [1065].

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

> 1.   Determining the scope and contents of the prior art.
> 2.   Ascertaining the differences between the prior art and the claims at issue.
> 3.   Resolving the level of ordinary skill in the pertinent art.
> 4.   Considering objective evidence present in the application indicating
>   obviousness or nonobviousness.

9.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

10.   Claims 7-9, 11-25 and 27-31 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schoen et al. (U.S. Pub. No. 20030204720) and in view of Creighton

et al. (U.S. Pub. No. 20020032665)

As per **claims 7 and 23**, Schoen et al. discloses a method/messaging server of

managing the exchange of secure online instant messages between subscriber devices,

where the secure messages are signed and encrypted using subscribers' digital

certificates ("PKI encrypted and/or signed IM packets" in fig. 1), the method comprising

operations of:

at one or more subscriber devices, an associated local instant messaging

module logging in to a messaging server to begin a session of exchanging synchronous

online messages (e.g. IM originator/recipient, IM Server in Fig. 1);

at one or more of the logged-in devices, the associated local instant messaging

module submitting a certificate publication request to a messaging server, the

publication request also specifying a digital certificate corresponding to the subscriber

device (e.g. par. [0074]);

responsive to each certificate publication request, the messaging server

temporarily storing the submitted digital certificate in a publication record in association

with the submitting device as long as the associated instant messaging module

remains logged-in to the messaging server (e.g. par. [0074]);

responsive to prescribed events, the messaging server providing logged-in

subscriber devices with selected information concerning certificates of other subscriber

devices (e.g. par. [0074]).

Schoen does not expressly disclosing receiving a particular subscriber device's

request to un-publish its digital certificate; responsive to receiving the request, the

messaging server removing the digital certificate from the publication record, identifying

other logged-in subscriber devices that previously designated the particular subscriber

device for potential future secured instant messaging, and notifying the identified

devices of the digital certificate withdrawn from use.

Creighton et al. discloses receiving a particular subscriber device's request to un-

publish its digital certificate; responsive to receiving the request, the messaging server

removing the digital certificate from the publication record, identifying other logged-in

subscriber devices that previously designated the particular subscriber device for

potential future secured instant messaging, and notifying the identified

devices of the digital certificate withdrawn from use by disclosing "The business owner

sends a request to delete the digital certificate issued to that business partner to the

certification authority. The certification authority checks the request, block 54, and

takes information from this request, block 68. The certification authority invalidates the

digital certificate by publishing it as an invalid digital certificate and

removing it from its database, block 70. The certification authority also

sends an update to the business owner, block 72, so the business owner may

remove the digital certificate from its database". (e.g. par. [0042]).

It would have been obvious to a person with ordinary skill in the art to combine

Creighton et al.'s receiving a particular subscriber device's request to un-publish its

digital certificate; responsive to receiving the request, the messaging server removing

the digital certificate from the publication record, identifying other logged-in subscriber

devices that previously designated the particular subscriber device for potential future

secured instant messaging, and notifying the identified devices of the digital certificate

withdrawn from use into Schoen et al. motivated by to improve security of instant

messaging group communication.

As per **claims 8 and 24**, Schoen further discloses the operation of, responsive to

prescribed events, providing logged-in subscriber devices with selected information

concerning certificate status of other subscriber devices comprising: responsive to a

request from one subscriber device to establish a dialog with another subscriber

device, the messaging server providing the requesting subscriber device with a

representation of a digital certificate of the other subscriber device from the publication

record (e.g. par. [0074]).

As per **claims 9 and 25**, Schoen further discloses the operation of, responsive to

prescribed events, providing logged-in subscriber devices with selected information

concerning certificate status of other subscriber devices comprising: responsive to a

particular subscriber device's request to publish a new digital certificate, the messaging

server identifying other logged-in subscriber devices that have

designated the particular subscriber device for potential future secured instant

messaging, and providing the identified devices with a representation of the new digital

certificate (e.g. par. [0074]).

As per **claim 11**, Creighton et al. further discloses comprising: the particular

subscriber device submitting the request to un-publish its digital certificate in response

to at least one of the following events: (1) physical unavailability of the subscriber

device's digital certificate, (2) logical unavailability of the subscriber device's

corresponding digital certificate, (3) user election to un-publish the subscriber device's

digital certificate (e.g. par. [0042]).

As per **claims 12 and 27**, Schoen further discloses the operation of, responsive

to prescribed events, providing logged-in subscriber devices with selected information

concerning certificate status of other subscriber devices comprising: responsive to a

request from a first subscriber device to establish a dialog with a second subscriber

device, the messaging server denying supplication of the second

subscriber's digital certificate to the first subscriber whenever the second subscriber's

digital certificate has experienced one or more of the following actions: invalidity,

revocation, un-publication (e.g. par. [0073]).

As per **claim 13**, Creighton et al. further discloses comprising: delaying submittal

of the certificate publication request under preventive circumstances including at least

one of the following: (1) physical unavailability of the digital certificate, (2) logical

unavailability of the digital certificate, (3) user election to delay publication of the digital

certificate (e.g. par. [0042]).

As per **claim 14**, Creighton et al. further discloses comprising: automatically

submitting the certificate publication request when the preventive circumstances

terminate (e.g. par. [0042]).

As per **claims 15 and 28**, Schoen further discloses the operation of, responsive

to prescribed events, providing logged-in subscriber devices with information

concerning certificate status of other subscriber devices comprising: responsive to a

particular subscriber device's published certificate becoming invalid, the messaging

server identifying other logged-in subscriber devices that previously

designated the particular subscriber device for potential future secured instant

messaging, and notifying the identified devices of the invalid digital certificate (e.g. par.

[0073]).

As per **claims 16 and 29**, Schoen further discloses the operation of temporarily

storing the submitted digital certificate additionally storing a representation of a chain

record pertaining to the certificate, where storage of repetitive chain records are

abbreviated to conserve storage space (e.g. par. [0074])

As per **claim 17**, Schoen further discloses the act of submitting the publication

request is performed under one or more of the following conditions: (1) automatically in

response to the act of logging in to the messaging server, (2) manually in response to operator direction (e.g. par. [0074]).

As per **claims 18 and 30**, Creighton et al. further discloses comprising operations of: at one or more of the logged-in devices, an associated local instant messaging module submitting a certificate un-publication request to the messaging server responsive to specified conditions; responsive to each un-publication request, the messaging server removing the requesting subscriber's digital certificate from the publication record (e.g. par. [0042]).

As per **claims 19 and 31**, Schoen further discloses where: the operations further comprise, responsive to each publication request, the messaging server receiving revocation information for the subscriber's certificate; upon expiration of the certificate as indicated by the revocation information, removing the subscriber's certificate from the publication record (e.g. par. [0073]).

As per **claims 20-22,** they are rejected using the same rationale as rejecting claims 7-9, 11-19, 23-25 and 27-31 above.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892).

In response to the current Office Action, the Applicant is respectfully requested to review all the reference cited by the examiner, in particular, Cooper et al. (U.S. Pub. No. 20020029350) discloses "Virtually **all web browser programs** such as NETSCAPE…have a mechanism to store and manipulate…digital certificates. It is

common to see an area reserved for the creation, deletion, storage, and usage of

digital certificates under the menu item named "options" or preference" in such web

browser programs".

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-

1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00

p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2135

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2135